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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/773,669	02/06/2004	Steffen Dubnack	GK-ZEI-3226/500343.20238	7534

26418 7590 11/25/2005

REED SMITH, LLP  
ATTN: PATENT RECORDS DEPARTMENT  
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EXAMINER

ROY, ANURADHA

ART UNIT PAPER NUMBER

3736

DATE MAILED: 11/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

TWK

<b>Office Action Summary</b>	<b>Application No.</b> 10/773,669	<b>Applicant(s)</b> DUBNACK ET AL.	
	<b>Examiner</b> Anuradha Roy	<b>Art Unit</b> 3736	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>February 6, 2004</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 & 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Gonzalez (US Patent No. 6,685,729).

Regarding claim 1, Gonzalez discloses a method for tissue-selective treatment in therapy and surgery comprising the steps of:

- positioning a probe (Column 5, lines 50-51 & Figure 2A, 28 & 30) in the area of the diseased change after placing on the body organ or body tissue to be treated;
- activating tissue selection (Column 5, lines 50-55, Figure 2A, 32) in that different electrical and/or electromagnetic stimulus signals which can be preadjusted or modulated are sent to the tissue in order to stimulate the latter (Column 5, lines 53-54);

- distinguishing the healthy tissue parts from the pathologically changed tissue parts (Column 5, lines 34-37) by evaluating the responses to these stimuli (Examiner contends that determining the pathologically changed tissue parts inherently determines the areas of healthy tissue);
- wherein, in the case of an expected stimulus response identifying healthy tissue (Column 5, lines 39-41), repositioning the probe and activating the tissue selection again, or when the stimulus response identifying pathologically altered tissue is absent or unexpected, carrying out the corresponding therapeutic or surgical treatment by the same probe at the selected site (Column 5, lines 22-30). Examiner contends repositioning of the probe is inherently required to identify the areas of dysfunction.

With regards to claim 2, Gonzalez further discloses a method for tissue-selective treatment, in which the tissue selection during the repositioning of the probe due to an expected stimulus response identifying healthy tissue can be carried out by iterative or continuous transmission of stimulus signals (Column 5, lines 56-67).

#### **Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gonzalez in view of Zealear et al. (US Patent No. 4,817,628).

Gonzalez discloses a method for tissue-selective treatment with all of the aforementioned steps as well as the step wherein a direct online tissue selection is carried out by alternating treatment and positioning with tissue selection (Column 5, lines 34-41) and immediate evaluation of the stimulus responses (Column 5, lines 50-67). Gonzalez, however, does not disclose a method in which the user is warned during treatment of critical tissue regions and/or where the therapy may be interrupted. However, Zealear et al. does teach of a method where the user is warned during treatment of critical tissue regions (Column 13, lines 67-68 & Column 14, lines 1-9) and/or where the therapy may be interrupted

### Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Raymond et al. (US Patent No. 5,775,331) discloses a method and system for locating a nerve and applying stimulation for therapeutic purposes.


Lerner et al. (US Publication No. 2002/0123678) discloses a method for the enhanced delivery of drug of interest to an internal organ or target tissue, for example the brain.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anuradha Roy whose telephone number is (571) 272-6169 and whose email address is anuradha.roy@uspto.gov. The examiner can normally be reached between 8:00am and 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on 571-272-4726.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

~AR~



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